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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/585,785

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David J. Chatting

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EXAMINER

FAN, CHARLES C

ART UNIT

PAPER NUMBER

2628

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DELIVERY MODE

05/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/585,785	Applicant(s) CHATTING ET AL.	
	Examiner CHARLES FAN	Art Unit 2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/16/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim do not expressly or implicitly require performance of any of the steps by a machine, such as a general-purpose computer. There are several tests that can be applied to determine whether claims are directed toward statutory subject matter. They include: (1) a process under 35 USC 101 requires a transformation of physical subject matter, tangible or intangible, to a different state or thing; (2) the “abstract idea” exception; and (3) the claim must recite a practical application, that is a useful, concrete, and tangible result. It is noted that claims that are broad enough to read on statutory and nonstatutory subject matter are considered nonstatutory. Claim 9 is directed to a computer program and do not require a transformation any physical subject matter, tangible or intangible, into a different state or thing. The claims are drawn simply to the computer software (i.e. software application), which is merely a set of instructions capable of being executed by a computer when the computer software is run on a computer for displaying a smear image taken with a scale factor. It is noted that claims to the computer program/software *per se* are not a process and without the computer-readable medium needed to realize the computer program/software’s functionality are nonstatutory functional descriptive material. See MPEP 2106 IV B 1(a). Specifically, a claim to computer program or a tangible computer-readable medium encoded with a computer program/software is statutory because it is a computer element, which defines structural and functional interrelationships between the computer program and other component of a computer, which permits the computer program/software’s functionality to be realized.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 9-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bouton et al. (“Inside Adobe Photoshop 5” Copyright May 1998).

In re claims 1, 9, 10, 11, Bouton et al. discloses storing image representation of subjects and corresponding caricatured image representations (page 93, Photoshop can save images and composed images) receiving an image of a new subject (Page. 266-267), and generating a caricatured image representation of the new subject in dependence on the stored image representation of the subjects and received image representation of the new subject (Page 274, figure 9.10).

In re claims 2, 12, Bouton et al. discloses storing image representations of subjects and corresponding respective caricatured image representations of the subjects (page 93, Photoshop can save images and composed images), receiving an image representation of a new subject (Page. 266-267), and generating replacement caricatured image representations of the subjects in dependence on the stored image representations thereof and the received image representation of the new subject (Page 269 Figure 9.4, as seen a plurality of images can be use to be composing the caricature images with the subject which can be used to save over the original file).

In re claims 3, 13, Bouton et al. discloses generating a caricatured image representation of the new subject in dependence on the stored image representations of the subjects and the

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received image representation of the new subject (Page 269 Figure 9.4, as seen a plurality of images can be use to be composing the caricature images with the new subject).

In re claims 5, 15, Bouton et al. discloses subject forming a closed group of subjects and the method is performed whenever a new subject joins the closed group (Page 269- 271, the images form a closed group as the images are placed as layers as seen in figure 9.6 and caricaturing of the images occurs when the images are placed as layers as seen in 9.7).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 4, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouton et al. ("Inside Adobe Photoshop 5" Copyright May 1998) in further view of Horii (US Pat. No. 5,850,463).

In re claim 4, 14, it is noted that Bouton et al. does not explicitly disclose weighted dependence on the received image representation of the new subject, wherein a weighting factor associated with the new image representation generally increases with time, and the caricature image representations are re-generated each time the weighting factor is adapted. However, Horii discloses image aging which causes the weighted value to increase over time (column 3, lines 4-16). It would have been obvious to one of ordinary skill to combine the aging of images with the image compositing of Bouton et al. with the motivation of simulating aging on images.

7. Claims 6, 8, 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouton et al. ("Inside Adobe Photoshop 5" Copyright May 1998) in further view of Dayton et al. ("Photoshop 5/5.5 Wow! Book" Copyright 2000).

In re claims 6, 16, it is noted that Bouton et al. does not explicitly disclose receiving a leave signal indicating a particular one or more of the subjects for which image representations are stored, and generating replacement caricatured image representations in dependence on the stored image representations of the subjects at least partially discounting the image representations of the indicated subjects. However, Dayton et al. discloses a leave signal indicating a particular one or more of the subjects for which image representations are stored (page 90, number 3. labeled paragraph, one can click on the eye button or "leave signal" to hide the image), and generating replacement caricatured image representations in dependence on the stored image representations of the subjects at least partially discounting the image representations of the indicated subjects (Page 90-91, Figure 1 and 3a, the image is generated showing the object missing). It would have been obvious to one of ordinary skill to combine the

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ability to remove layers of Dayton et al. with the image compositing of Bouton et al. with the motivation of giving option to remove unneeded layers.

In re claim 8, 18, it is noted that Bouton et al. does not disclose explicitly disclose the subjects form a closed group of subjects, and the method is performed whenever one or more of the subjects leave the closed group. However, Dayton et al. discloses deleting a layer (Page 80, sidebar, the remove of which would take it out of the closed group of layer and display it without the image). It would have been obvious to one of ordinary skill to combine the ability to delete layers of Dayton et al. with the image compositing of Bouton et al. with the motivation of giving option to delete unneeded layers.

8. Claims 7, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouton et al. ("Inside Adobe Photoshop 5" Copyright May 1998) in further view of Dayton et al. ("Photoshop 5/5.5 Wow! Book" Copyright 2000), and Astle (US Pat. No. 4,698,682).

In re claim 7, 17, it is noted that Bouton et al. and Dayton et al. does not disclose indicated subjects are generally increasingly discounted over time in accordance with a weighting factor, wherein the caricature image representations are re-generated each time the weighting factor is adapted. However, Astle discloses image transition via fading which progressive switches from one image to the next discounting the first image for the second image (Column 4, lines 22-42). It would have been obvious to one of ordinary skill to combine the removal of layers as taught by Dayton et al. with the transitioning of images as taught by Astle with the motivation of creating animation.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Huang et al (US Pat. No. 6,229,904) discloses a morphing photography booth, Lambertsen (US Pub. No. 2002/0024528) discloses a virtual makeover system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES FAN whose telephone number is (571)270-3550. The examiner can normally be reached on mon- fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xiao Wu can be reached on (571)272-7761. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/XIAO M. WU/
Supervisory Patent Examiner, Art Unit 2628